

REMARKS

Claims 1-29 are pending in this application. For purposes of expedition, claims 1-2, 8-9, 17, 19, 21-25 and 27-28 have been amended in several particulars for purposes of clarity and brevity that are unrelated to patentability and prior art rejections in accordance with current Office policy, to further and alternatively define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application.

Claims 1-14, 22-24, and 28-29 have been rejected under 35 U.S.C. §102(b) as being anticipated by Kondo, U.S. Patent No. 5,177,720. In support of the rejection of Applicants' base claims 1, 8, 19, 22 and 28, the Examiner asserts, among others, that Kondo '720 discloses an optical information storage medium, as shown in FIG. 8, comprising a reproduction-only area, and a recordable area "wherein new data about a disk state is recorded in the recordable area every time a recording of user data is stopped" (column 7, lines 35-55)."

However, the Examiner's assertion is factually incorrect. Applicants submit that the features of Applicants' base claims 1, 8, 19, 22 and 28 are not disclosed or suggested by Kondo '720. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection for the following reasons.

In contrast to Applicants' base claims 1, 8, 19, 22 and 28, Kondo '720 discloses an optical disc recording system for recording data on a writable type optical disc, as shown in FIG. 1, designed to shorten time for generating program information and TOC (table of content) information so as to be recorded on a program area and a TOC area on an optical disc. According to Kondo '720, when program information is recorded program by program separately and with interruption and the TOC information is recorded later, position information necessary for producing the TOC information is recorded during each interruption at a position inside of a TOC area on the optical disc and this position information is read when writing of program information is resumed for later utilization so as to save time required for collecting position information necessary for generation of the TOC information and thus shorten time required for generation of the TOC information.

As described on col. 1, lines 37-46 of Kondo '720, program information can be music data recorded with position information (i.e., data representing position such as an address, time and music number). TOC information includes a program number, start time for each program,

total program number and finish time of all programs. Such TOC information is recorded in a TOC area of a disc.

As can be appreciated, Kondo '720 does **not** disclose or suggest the use of any recordable area on an optical disc in which "new data about a disk state is recorded in the recordable area if a recording of user data is stopped" as alleged by the Examiner. In fact, the cited column 7, lines 35-55 of Kondo '720 only refers to the use of a TOC generator 52, as shown in FIG. 9, to generate TOC information on the basis of position information stored in the position information memory section 50. According to Kondo '720, in a case where program information is recorded program by program separately with interruption, position information (intermediate information) stored in the position information memory section 50 is read out at each time point when recording is interrupted by, e.g., operation of an operator. TOC information includes, for example, the music number, start point of each music piece, which have been written by the time point of interruption of the program.

Again, there is **no** disclosure from Kondo '720 nor is there any teaching or suggestion of the Applicants' claimed "new data about a disk state is recorded in the recordable area if a recording of user data is stopped" as expressly defined in base claims 1, 8, 19, 22 and 28.

The rule under 35 U.S.C. §102 is well settled that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). In addition, the prior art reference must be enabling. Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). The corollary of that rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986).

The burden of establishing a basis for denying patentability of a claimed invention rests upon the Examiner. The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are

functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

In the present situation, Kondo '720 fails to disclose and suggest features of Applicants' base claims 1, 8, 19, 22 and 28. Therefore, Applicants respectfully request that the rejection of claims 1-14, 22-24, and 28-29 be withdrawn.

Claims 1, 8, 15, 17, 19, and 25 have been rejected under 35 U.S.C. §102(b) as being anticipated by Fukushima et al., U.S. Patent Application Publication No. 2001/0036136 for reasons stated on pages 5-6 of the Office Action. In particular, the Examiner also cites FIG. 2, element 204 and paragraph [0204] of Fukushima '136 for allegedly disclosing Applicants' claimed "recordable area wherein new data about a disk state is recorded in the recordable area every time a recording of user data is stopped." However, the Examiner's citation is misplaced. Applicants respectfully traverse the rejection, noting that Fukushima '136 only discloses an optical disc 101, as shown in FIG. 1, including a disc information area 104 and a data area 105. In the disc information area 104 (204, shown in FIG. 2), various parameters required to access the optical disc 101 are recorded, including guard areas 205, as shown in FIG. 2, a disc test area 106 used for testing the quality of the optical disc 101 in a production process, a drive test area 207 used by an optical disc apparatus for checking the state of the optical disc 101 mounted on the optical disc apparatus, a disc ID area 206 used for recording information on various characteristics of the optical disc 101, and a defect management area 209 for recording defect management information.

The cited paragraph [0204] of Fukushima '136 only refers to the recording power adjustment and the update of drive information. Specifically, the recording power condition acquired is used by the recording power adjusting processing section 573, as shown in FIG. 12, to update the drive information. However, the drive information as described by Fukushima '136 is not, and cannot be interpreted to correspond to Applicants' claimed "data about a disk state" or "disk state data" if a recording of user data is completed. This is because the drive information of Fukushima '136 is the same drive information recorded in a drive zone, as shown in FIG. 1, which is completely different from Applicants' claimed "data about a disk state" or "disk state data" which includes, for example, an address of an area containing newly recorded

optimum power control (OPC) data, an address of an area containing most recently recorded drive data, an address of an area containing most recently recorded user data, and data representing whether an additional recording is possible after the recording of user data is completed.

In view of these reasons and the noted deficiencies of Fukushima '136, Applicants respectfully request that the rejection of claims 1, 8, 15, 17, 19, and 25 be withdrawn.

Claims 16, 18, and 25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fukushima et al., U.S. Patent Application Publication No. 2001/0036136 for reasons stated on pages 7-8 of the Office Action. Lastly, claims 19-21, 25, and 27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Kondo, U.S. Patent No. 5,177,720, in view of Fukushima et al., U.S. Patent Application Publication No. 2001/0036136 for reasons stated on pages 8-9 of the Office Action. However, both Kondo '720 and Fukushima '136 fail to disclose or suggest key features of Applicants' claimed invention for reasons discussed above. As a result, Applicants respectfully traverse these rejections for the same reasons discussed.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505 ext. 232.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

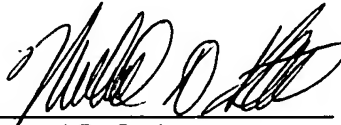
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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